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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,683	06/11/2001	Limor Schweitzer	AMDCP006	4994

28875   7590   08/31/2009
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EXAMINER
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ART UNIT	PAPER NUMBER
3692	

NOTIFICATION DATE	DELIVERY MODE
08/31/2009	ELECTRONIC

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1   UNITED STATES PATENT AND TRADEMARK OFFICE
2   _____
3
4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* LIMOR SCHWEITZER
9   _____
10
11   Appeal 2009-000983
12   Application 09/879,683
13   Technology Center 3600
14   _____
15
16   Decided: August 27, 2009
17   _____
18
19
20   *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
21   BIBHU R. MOHANTY, *Administrative Patent Judges.*
22
23   CRAWFORD, *Administrative Patent Judge.*
24
25
26   DECISION ON APPEAL
27
28   STATEMENT OF THE CASE
29   This is an appeal from the final rejection of claims 1, 3, 8-13, 15, 20-

30   28, and 30. We have jurisdiction to review the case under 35 U.S.C. §§ 134

31   and 6 (2002).

1   The claimed invention is directed to systems, methods, and computer

2   program products for paying a transaction over the Internet (Abstract).

3   Claim 1, reproduced below, is further illustrative of the claimed

4   subject matter.

5   1. A method for paying for a transaction over the
6   Internet, comprising:
7   receiving information utilizing a network, wherein the
8   information includes an Internet Protocol (IP) address of a user
9   and an amount of payment due;
10   identifying an account using at least a portion of the IP
11   address; and
12   administering payment for the payment due by billing
13   against the account;
14   wherein user data is identified based on the received
15   information, and the user data is sent to a site, wherein the user
16   data includes shipping information;
17   wherein the site sends the information in response to the
18   user carrying out a transaction using the site;
19   wherein a uniform resource locator (URL) link is
20   provided to the user from the site, where the URL allows the
21   user to give permission for the payment to be administered,
22   and, in response to the user giving the permission, the site is
23   provided with a confirmation number and the shipping
24   information of the user and the user is provided with the
25   confirmation number;
26   wherein the receiving, the identifying, and the
27   administering are carried out by a network service provider.
28

29   The references of record relied upon by the Examiner as evidence of

30   obviousness are:

31   Egendorf   US 5,794,221   Aug. 11, 1998
32   Wilf   US 5,899,980   May 4, 1999
33   Ronen   US 5,905,736   May 18, 1999
34   Foster   US 6,332,134 B1   Dec. 18, 2001
35

1   John Stewart, *Connecting With Confidence*, 5 Web Techniques, 84
2   (2000) (hereinafter "Stewart").
3
4   Claims 1, 3, 8-12, 27, 28, and 30 stand rejected under 35 U.S.C. §
5   112, second paragraph, for indefiniteness; claims 1, 8-11, 13, 20-23, 25-28,
6   and 30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ronen
7   in view of Egendorf and Foster; claims 12 and 24 stand rejected under 35
8   U.S.C. § 103(a) as unpatentable over Ronen in view of Egendorf, Foster, and
9   Wilf; claims 3 and 15 stand rejected under 35 U.S.C. § 103(a) as
10   unpatentable over Ronen in view of Egendorf, Foster, and Stewart.
11   We AFFIRM.
12
13   ISSUES
14   Did the Appellant show the Examiner erred in finding that "the
15   information" in "wherein the site sends the information," as recited in
16   independent claim 1, lacks an antecedent basis, because it is unclear whether
17   "the information" refers to received information or shipping information?
18   Did the Appellant show the Examiner erred in finding that "wherein
19   the site sends the information in response to the user carrying out a
20   transaction using a site," as recited in independent claim 1, is indefinite
21   because it is unclear where the site is sending the information?
22   Did the Appellant show the Examiner erred in finding that a
23   combination of Ronen and Egendorf renders obvious identifying user data
24   based on received information, the user data including shipping information,
25   as recited in independent claims 1, 13, 25, and 26, because the shipping
26   information in both Ronen and Egendorf is provided by the user?

1   Did the Appellant show the Examiner erred in finding that Foster

2 discloses providing the site with a confirmation number and the shipping

3 information of the user, the user being provided with the confirmation

4 number, as recited in independent claims 1, 13, 25, and 26, because Foster

5 discloses that an order confirmation number is sent to the cardholder while a

6 unique order number, different from the order confirmation number, is sent

7 to the merchant?

8   Did the Appellant show the Examiner erred in finding that Ronen

9 discloses providing a link to a site on a network where a business transaction

10 is occurring, as recited in independent claim 26?

11   Did the Appellant show the Examiner erred in finding that Ronen

12 discloses conditionally administering payment for the payment due by

13 billing against the account in accordance with any identified rules, as recited

14 in independent claim 26, because Ronen merely discloses when a particular

15 billing method is to be applied as opposed to whether a payment should be

16 made at all?

17   Did the Appellant show the Examiner erred in finding that Ronen

18 discloses a rule identifying at least one category in which goods or services

19 are permitted to be purchased, as recited in dependent claim 30, because

20 Ronen does not identify any categories of goods and services which are not

21 permitted to be purchased?

22   Did the Appellant show the Examiner erred in finding that Wilf

23 discloses "wherein the receiving, the identifying, and the administering are

24 carried out by a financial institution offering credit with credit cards in

25 conjunction with the network service provider," as recited in dependent

4

1   claim 12, because Wilf does not disclose that the financial institution is the

2   sole entity carrying out the receiving, identifying, and administering steps?

3   Did the Appellant show the Examiner erred in finding that Wilf

4   discloses "wherein the computer code is executed by a financial institution

5   offering credit with credit cards in conjunction with the network service

6   provider," as recited in dependent claim 24, because Wilf does not disclose

7   that the financial institution is the sole entity carrying out the computer

8   code?

9   Did the Appellant show the Examiner erred in finding that Stewart

10   discloses that the information includes port numbers, as recited in dependent

11   claims 3 and 15?

12

13   FINDINGS OF FACT

14   *Specification*

15   The claimed invention is directed to systems, methods, and computer

16   program products for paying a transaction over the Internet (Abstract).

17   In response to a user carrying out a transaction using an e-commerce

18   site, the system receives information from the e-commerce site utilizing a

19   network (Spec. 7:5-17).

20   The present invention may be carried out by a financial institution

21   offering conventional credit through credit cards in conjunction with a

22   network service provider who provides the user with access to the network.

23   During each transaction, the user may provide his/her credit card

24   information to the financial institution, which is then correlated with the user

25   account information stored with the network service provider. This leads to

26   strengthened user authentication that greatly reduces fraud (Spec. 8:4-10).

1   *Ronen*

2   Ronen discloses that the Internet can provide users a mechanism for

3   ordering various goods and services, including tickets and merchandise, that

4   will later be delivered by conventional transport means (col. 1, ll. 13-16).

5   An Internet Protocol (IP) address is assigned to a user connected

6   through an Internet Access Provider (IAP) to one or more Internet Service

7   Providers (ISPs). The IP address, together with the associated identity of the

8   user, is transmitted to the billing platform and transaction server 109 by the

9   IAP. In response to a chargeable transaction, the ISP transmits to the billing

10   platform and transaction server 109 the IP address identity of the user

11   making the transaction and the cost associated with the transaction. The

12   billing platform and transaction server 109 then cross-reference the IP

13   address associated with the cost of the transaction received from the ISP

14   with the IP-address/user-identity relationship received from the IAP to

15   properly charge an established account of the user for the transaction. If

16   such an account exists on database 110 and a billing mechanism is in place,

17   ISP 106 is signaled over the secured link by transaction server 109, to

18   authorize the transaction (col. 2, ll. 5-20; col. 5, ll. 52-66).

19   The user may provide his or her selected choices for how charges for

20   transactions on the Internet are to be billed. The user may specify that

21   certain transactions, depending upon the type of transaction, be billed in a

22   specific manner in accordance with specific parameters (col. 4, ll. 20-65).

23

24   *Egendorf*

25   Egendorf discloses that in an Internet transaction, a vendor may verify

26   with the provider that an address supplied by the customer for shipment of

1   goods has been authorized by the customer in the same manner in which

2   such verification would be made for the same transaction made over the

3   telephone with a credit card (col. 4, ll. 1-6).

4

5   *Foster*

6   Foster discloses that in authorizing an Internet transaction between a

7   cardholder and a merchant, a card company system may provide an order

8   confirmation number to the cardholder, and a unique order number and pre-

9   registered shipping address to the merchant (col. 8, ll. 42-50).

10

11   *O'Neil*[1]

12   O'Neil discloses that Bill Payment Web Page 340 presented to the

13   user includes a field 342 for displaying the confirmation number. Bill

14   payment server 120 transmits an approval confirmation message including

15   the transaction identifier, approval flag, and confirmation number to

16   merchant server 110. The user's credit card information, however, is not

17   disclosed to the merchant, and thus, the potential for fraud is eliminated

18   ([0026]-[0027]).

19

20   PRINCIPLES OF LAW

21   *Claim Construction*

22   Quite apart from the written description and the prosecution history,

23   the claims themselves provide substantial guidance as to the meaning of

---

[1] U.S. Patent Application Publication No. US 2002/0069165 A1, published
Jun. 6, 2002, to O'Neil was not formally cited in a claim rejection, but was
previously made of record by the Examiner.

1   particular claim terms. To begin with, the context in which a term is used in

2   the asserted claim can be highly instructive. *Phillips v. AWH Corp.*, 415

3   F.3d 1303, 1314 (Fed. Cir. 2005) (internal citations omitted).

4   The specification is always highly relevant to the claim construction

5   analysis. Usually, it is dispositive; it is the single best guide to the meaning

6   of a disputed term. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576,

7   1582 (Fed. Cir. 1996).

8   While the specification can be examined for proper context of a claim

9   term, limitations from the specification will not be imported into the claims.

10   *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.

11   2005).

12   During examination of a patent application, a pending claim is given

13   the broadest reasonable construction consistent with the specification and

14   should be read in light of the specification as it would be interpreted by one

15   of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d

16   1359, 1364 (Fed. Cir. 2004).

17

18   *Indefiniteness*

19   A claim is definite if "one skilled in the art would understand the

20   bounds of the claim when read in light of the specification." *Personalized*

21   *Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 705 (Fed. Cir.

22   1998).

1   ANALYSIS

2   *Antecedent Basis*

3   We are persuaded of error on the part of the Examiner by Appellant's

4   argument that "the information" in "wherein the site sends the information,"

5   as recited in independent claim 1, does not lack an antecedent basis, because

6   "the information" refers to the received information (App. Br. 11; Ex. Ans.

7   13-14; Reply Br. 2-3). "The information" in line 9 of independent claim 1 is

8   merely a repeat of "the information" in line 3, i.e., the received information.

9   It is possible that "the information" in line 9 could refer to the shipping

10   information. However, because lines 7-8 of independent claim 1 recite that

11   the user data, including the shipping information, is sent *to* a site, one of

12   ordinary skill would understand that it makes much more sense for the site to

13   send the received information, then to apparently resend the shipping

14   information sent to it in the first place. *See Phillips v. AWH Corp.*, 415 F.3d

15   at 1314. This claim construction is confirmed by page 7, lines 5-17 of the

16   Specification, which discloses that the e-commerce site sends the received

17   information. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d at 1582.

18

19   *Sending Information*

20   We are persuaded of error on the part of the Examiner by Appellant's

21   argument that "wherein the site sends the information in response to the user

22   carrying out a transaction using a site," as recited in independent claim 1, is

23   not indefinite because it is unclear where the site is sending the information

24   (App. Br. 11). Both the Appellant and the Examiner agree that the site is

25   sending the information to some undisclosed location (App. Br. 11; Ex. Ans.

26   13-14). As both sides agree on the bounds, the recitation is definite. *See*

1   *Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d at

2   705. While the recitation may be broad, that alone does not render it

3   indefinite.

4

5   *Shipping Information*

6   We are not persuaded of error on the part of the Examiner by

7   Appellant's argument that a combination of Ronen and Egendorf does not

8   render obvious identifying user data based on received information, the user

9   data including shipping information, as recited in independent claims 1, 13,

10   25, and 26, because the shipping information in both Ronen and Egendorf is

11   provided by the user (App. Br. 11-13, 16; Reply Br. 3-9, 17-20). As an

12   initial matter, we note that none of independent claims 1, 13, 25, and 26

13   recite that the shipping information cannot be provided by the user. *See*

14   *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at 1231.

15   Moreover, Ronen discloses that user data is identified based upon the

16   IP address received from the ISP. Egendorf discloses that user data may

17   include shipping information, regardless of how the shipping information

18   came to be a part of the user data. Ronen further discloses that goods may

19   be delivered by conventional transport means. Thus, the Examiner asserts

20   the reason to include the shipping information of Egendorf in the user data

21   of Ronen is to provide a shipping address to which goods can be delivered

22   (Ex. Ans. 14-17). The Appellant has not persuasively shown the flaws in the

23   rationale for combining Ronen and Egendorf in this manner to render

24   obvious user data including shipping information.

1   *Confirmation Number*

2   We are persuaded of error on the part of the Examiner by Appellant's

3   argument that Foster does not disclose providing the site with a confirmation

4   number and the shipping information of the user, the user being provided

5   with the confirmation number, as recited in independent claims 1, 13, 25,

6   and 26, because Foster discloses that an order confirmation number is sent to

7   the cardholder while a unique order number and a pre-registered shipping

8   address, different from the order confirmation number, is sent to the

9   merchant (App. Br. 13-14, 15; Reply Br. 9-11, 13-14). However, O'Neil

10   discloses that the same confirmation number is displayed to the user and the

11   merchant. The reason for combining the confirmation number of O'Neil

12   with Ronen, Egendorf, and Foster is to allow the user and the merchant to

13   easily identify the same transaction by confirmation number should a dispute

14   arise.

15   Because the rationale for the basis of this rejection differs from that

16   set forth by the Examiner, we denominate our affirmance of the rejection of

17   independent claims 1, 13, 25, and 26 as a new ground of rejection under 37

18   C.F.R. § 41.50(b). Due to their dependence from one of independent claims

19   1, 13, 25, and 26, we also denominate our affirmance of the rejection of

20   dependent claims 8-11, 20-23, 27-28, and 30, under 35 U.S.C. § 103(a) as

21   unpatentable over Ronen in view of Egendorf, Foster, and O'Neil, as a new

22   ground of rejection under 37 C.F.R. § 41.50(b). We also set forth new

23   grounds of rejection, under 37 C.F.R. § 41.50(b), for claims 12 and 24 being

1   unpatentable under 35 U.S.C. § 103(a) over Ronen in view of Egendorf,

2   Foster, O'Neil, and Wilf; and for claims 3 and 15 being unpatentable under

3   35 U.S.C. § 103(a) over Ronen in view of Egendorf, Foster, O'Neil, and

4   Stewart.

5

6   *Business Transaction*

7   We are not persuaded of error on the part of the Examiner by

8   Appellant's argument that Ronen does not disclose providing a link to a site

9   on a network where a business transaction is occurring, as recited in

10   independent claim 26 (App. Br. 15; Reply Br. 15-16). Ronen discloses that

11   a user interacts with ISP 106 to complete one or more transactions. ISP 106

12   then communicates with transaction server 109 to determine whether the

13   user's IP address has an established billing entry to which charges for the

14   transaction can be forwarded and recorded. If such a billing entry has been

15   established, transaction server 109 signals ISP 106 over a secured link to

16   authorize the transaction. Accordingly, the secured link to ISP 106, on

17   which the user is completing one or more transactions, corresponds to the

18   link to a site on a network where a business transaction is occurring, as

19   recited in independent claim 26.

20

21   *Conditionally Administering Payment*

22   We are not persuaded of error on the part of the Examiner by

23   Appellant's argument that Ronen does not disclose conditionally

24   administering payment for the payment due by billing against the account in

25   accordance with any identified rules, as recited in independent claim 26,

26   because Ronen merely discloses when a particular billing method is to be

1 applied as opposed to whether a payment should be made at all (App. Br.

2 15-16; Reply Br. 16-17). Determining when a particular billing method is to

3 be applied, as disclosed in Ronen, is conditionally administering payment

4 for the payment due by billing against the account in accordance with any

5 identified rules. While the Appellant may have meant the conditionally

6 administering step to be construed as determining whether a payment should

7 be made at all, such a recitation is not set forth in the claims, and thus is not

8 given any weight. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d at

9 1231.

10 *Permitting Categories*

11 We are not persuaded of error on the part of the Examiner by

12 Appellant's argument that Ronen does not disclose a rule identifying at least

13 one category in which goods or services are permitted to be purchased, as

14 recited in dependent claim 30, because Ronen does not identify any

15 categories of goods and services which are not permitted to be purchased

16 (App. Br. 17; Reply Br. 20-22). By determining when a particular billing

17 method is to be applied for particular categories of goods, Ronen is

18 inherently disclosing that each of those categories of goods *are* permitted to

19 be purchased. While the Appellant may have meant the identifying step to

20 be construed as determining whether a particular category of goods and

21 services are *not* permitted to be purchased, such a recitation is not set forth

22 in the claims, and thus is not given any weight. *See Id.*

23

24 *Financial Institution*

25 We are not persuaded of error on the part of the Examiner by

26 Appellant's argument that Wilf does not disclose "wherein the receiving, the

1 identifying, and the administering are carried out by a financial institution
2 offering credit with credit cards in conjunction with the network service
3 provider," as recited in dependent claim 12, because Wilf does not disclose
4 that the financial institution is the sole entity carrying out the receiving,
5 identifying, and administering steps (App. Br. 18; Reply Br. 22-25). As an
6 initial matter, we note that by using the words "in conjunction" in this
7 manner, the broadest reasonable interpretation of the claim is that a
8 *combination* of the financial institution and network service provider are
9 carrying out the receiving, the identifying, and the administering steps. *See*
10 *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1364. Accordingly, as long as
11 *some* of the steps are being carried out by the financial institution in Wilf,
12 which Appellant does not appear to dispute, the claim recitation is met.

13   While the Appellant may have meant the receiving, the identifying,
14 and the administering steps to be construed as being *solely* carried out by the
15 financial institution, such a recitation is not set forth in the claims, and thus
16 is not given any weight. *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418
17 F.3d at 1231. Furthermore, the Specification is of no assistance to Appellant
18 in advancing the "sole entity" claim construction, as page 8, lines 4-10 fail to
19 provide further details as to how the tasks of fulfilling the aforementioned
20 steps are divided between the financial institution and the network service
21 provider.

22   Dependent claim 24 recites "wherein the computer code is executed
23 by a financial institution offering credit with credit cards in conjunction with
24 the network service provider." For the same reasons as set forth above with
25 respect to a similar recitation in dependent claim 12, we also sustain the
26 rejection of dependent claim 24.

1   *Port Numbers*

2   We are not persuaded of error on the part of the Examiner by

3 Appellant's argument that Stewart does not disclose that the information

4 includes port numbers, as recited in dependent claims 3 and 15 (App. Br. 20-

5 21; Reply Br. 28-30). Appellant appears to be asserting that Stewart does

6 not disclose both the information *and* the port numbers. However, Ronen is

7 cited as disclosing receiving the "information," which in independent claims

8 1 and 15 includes an IP address and amount of payment due. *See In re*

9 *Keller*, 642 F.2d 413, 426 (CCPA 1981). Stewart is cited as disclosing port

10 numbers. The Examiner has combined Ronen and Stewart such that the port

11 numbers of Stewart are merely one more category of "information" received

12 in Ronen. Absent additional arguments by the Appellant as to why the cited

13 combination of Ronen and Stewart does not disclose information including

14 port numbers, we will sustain this rejection.

15

16   DECISION

17   The decision of the Examiner to reject claims 1, 3, 8-13, 15, 20-28,

18 and 30 is affirmed.

19   We use our authority under 37 C.F.R. § 41.50(b) to enter new

20 rationales for rejecting claims 1, 8-11, 13, 20-23, 25-28, and 30 under 35

21 U.S.C. § 103(a) as unpatentable over Ronen in view of Egendorf, Foster, and

22 O'Neil; claims 12 and 24 under 35 U.S.C. § 103(a) as unpatentable over

23 Ronen in view of Egendorf, Foster, O'Neil, and Wilf; and claims 3 and 15

24 under 35 U.S.C. § 103(a) as unpatentable over Ronen in view of Egendorf,

25 Foster, O'Neil, and Stewart.

1   37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection

2 pursuant to this paragraph shall not be considered final for judicial review."

3   Regarding the new ground of rejection, Appellant must, WITHIN

4 TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of

5 the following options with respect to the new ground of rejection, in order to

6 avoid termination of the appeal as to the rejected claims:

7   (1) *Reopen prosecution*. Submit an appropriate amendment of the
8   claims so rejected or new evidence relating to the claims so rejected,
9   or both, and have the matter reconsidered by the examiner, in which
10   event the proceeding will be remanded to the examiner. . . [; or]

11   (2) *Request rehearing*. Request that the proceeding be reheard under
12   § 41.52 by the Board upon the same record. . . .

13   No time period for taking any subsequent action in connection with

14 this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

15

16   AFFIRMED, 37 C.F.R. § 41.50(b)

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